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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/394,968 | 09/10/1999 | PHILLIP LEE SCANLAN | 2001.2.4 | 5208 |
| 21552 | 7590 | 12/31/2003 | EXAMINER | |
| MADSON & METCALF GATEWAY TOWER WEST SUITE 900 15 WEST SOUTH TEMPLE SALT LAKE CITY, UT 84101 | | | EDOUARD, PATRICK NESTOR | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2654 | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/394,968

Applicant(s)
SCANLAN

Examiner
Patrick N. Edouard

Art Unit
2654



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Oct 6, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 18-23 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ -Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 18-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

1. This Office Action is in response to communication filed 2/14/03 (paper #11) . Claims 1-16, 18- 23 are pending. Claims 24-28 are cancelled.

Claim Rejections - 35 USC § 112

2. Claims 1, 13, 19, 21 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitations “forwarding the communication, if required, the machine translation and if required, the quotation to the recipient” an “wherein the communication and , if required, the machine translation and, if required, the quotation are forwarded substantially simultaneously to the recipient” are vague and indefinite. It is unclear since the language “if required” is used whether all the limitations (communication, translation and quote) are forwarded or only the limitations that required (communication or translation or quote) are forwarded to the recipient. The examiner will assume that only some of the limitations are required to be forwarded to the recipient.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-16 and 18-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Application No 10124516 ("JP516") in view of Church (5,608,622) and Globalink (Globalink links up on-line professional translation service to users desktops)

JP516 teaches a method for automatically processing of electronic communication including the steps of"

"sending a communication from a sender in a first language"; (a mail translation managing part 3... and manages the translation processing of the electronic mail)

" identifying the communication as a foreign language" (a mail translation managing part 3... and manages the translation processing of the electronic mail);

" determining if a translation of the communication to a native language is required by the recipient" (a mail translation managing part 3... judges whether or not the reception ... and manages the translation processing of the electronic mail);

applying a translation program to the communication to generate a machine translation if a translation...by a recipient"(a translating processing part 4 receives the mail...translation managing part 4).

It is noted that JP516 teaches the claimed invention but does not explicitly teach automatically determining if a quotation for human translation of the communication to the second language may be required by the recipient" .However, this feature is well known in the art

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as evidenced by Church who teaches at col. 5, lines 1-30, when the translation received a job from a client, it enters information about the job, then analyses the document to be translated and gives the customer a price. Also , If the client decides to go ahead with the translation, the document is transferred to a human translator to have the document translate. Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to incorporate into the translation processing system of JP156 a translation system using a human operator as taught by Church because it would provide to users the ability to request a translation using either a machine translation or a human translator that would make the system more versatile and more attractive to be used.

It is noted that the combination teaches the translation assistant 101 includes a translation manager part 103 which is used by employees of the service bureau whose job is to manage the production of translation by the bureau translators but does not explicitly teach "applying a quotation program to the communication to generate a quotation..." . However, this feature is well known in the art as evidenced by Globalink which teaches based on the level of service selected, the programme quickly calculates a price for the translation. Therefore, one of ordinary skill in the art at the time the invention was made would have it obvious to replace the bureau's translators by the programme as taught by Globalink because it would make the system automated capable of providing fast, convenient , affordable and accessible to everyone.

Forwarding the communication and, if required the machine translation and, if required, the quotation to the recipient and wherein the communication and, if required the machine

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translation and, if required the quotation are forwarded substantially simultaneously to the recipient (the machine translation, the document and the quote and any combination thereof resulting from the combination (JP516, Church and Globalink) are forwarded to the recipient).

As per claim 2, JP516, the recipient formulating a response to the communication (the recipient will respond to the mail);

“Identifying the response as a native language response..communication” (the mail system could be used to determine if the recipient response needed be translated into the sender language”;

“If required by the sender applying a machine translation program to the native language... forwarding the foreign language” (the sender can request the recipient response be translated to his native language”

As per claim 3, the combination teaches “ further including the step of ...foreign language” (the combination teaches that the translation could be done using the translation machine of JP516 or the translator of Church).

As per claims 4-6 JP516 teaches wherein the sender directs communication to an email address (a mail translation managing part...);

As per claims 7-10, Church teaches said quotation are sent to the recipient by email (col. 5, lines 1+)

As per claims 11-12, JP516 teaches wherein the step of identifying the communication as a foreign language communication.. (a mail translation managing part 3...).

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5. Claims 13-16 and 18-23 are the same in scope and content as claims 1-12 above and therefore are rejected under the same rationale.

5. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231 or faxed to:

(703) 308-9051, (for formal communications intended for entry) Or:

(703) 305-9508 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 11, 2121 Crystal Drive, Arlington, VA.,

Sixth Floor (Receptionist).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick N. Edouard whose telephone number is (703) 308-6725. The examiner can normally be reached on Tuesday-Friday from 07:30 a.m.-6:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richemond Dorvil, can be reached on (703) 305-9645.

The facsimile phone number for this Art Unit is (703) 872-9314. Alternatively, facsimile messages may be sent directly to (703) 305-9644 where they will be stored in the examiner's voice mailbox

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(telling the examiner that a fax was received) and be automatically printed (i.e. - no delay by the examiner).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Patrick N. Edouard

December 19, 2003



PATRICK N. EDOUARD
PATENT EXAMINER